

### **REMARKS**

Claims 1, 3-20 are pending in the application. Claims 1, 3-20 stand rejected.

Claims 1 and 3-20 are rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,619,500 to Hickali in view of U.S. Patent No. 5,426,636 to Hiller et al. ("Hiller").

The MPEP 2143 requires to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. And third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant's claim 1 recites, ". . . said network control elements each including a network control switch and a plurality of channel cluster modules, wherein the channel cluster modules are each arranged for transmitting downstream signals on a respective carrier frequency. . . , said access node switch controlling all of the access-network-specific switching without said access node switch having to know a carrier frequency allocated to a terminal coupled to a sub-network of the plural sub-networks." (emphasis added).

Hickali fails to disclose or suggest at least these features of claim 1. The Office Action points to Hickali ABSTRACT, col. 2, lines 5-53, col. 3, lines 3-59, col. 14, lines 20-60.

In these sections of Hiekali fails to disclose or suggest that channel cluster modules are each arranged for transmitting downstream signals on a respective carrier frequency." The Office Action points to the SIMs 401-1 through 401-j of Hiekali, "each capable of communicating to a user via one or more T1 channels." It is again respectfully submitted that there is no suggestion at all that the T1 channels are being transmitted to each user on a respective carrier frequency.

Still further, Applicant claims said access node being configured to direct a signal from said network switch to a terminal of the plural terminals intended as a destination, thereby said network switch is relieved of knowing details of said access network that said network switch would otherwise need for directing said signal to an intended destination terminal.

In contrast, the Hiekali teaches that for each of the connecting ATM gateways 302-1, . . . 302-N, the Hiekali network switch 301 (col. 2, line 9: "ATM network switch") must know which of the plurality of incoming connections (col. 3, lines 47: "two T3 connections") to route messages over. The Hiekali network switch 301 *accordingly must know details of said access network* for connecting ATM gateways 302-1, . . . 302-N.

The addition of Hiller fails to cure the infirmities of Hiekali. Applicant cannot find any disclosure or suggestion that channel cluster modules are each arranged for transmitting downstream signals on a respective carrier frequency in Hiller. Instead, Hiller teaches away from the present invention since it relates to standard time division multiplexing (TDM) of T1 lines (col. 27, line 41: "time multiplexed switch"; col. 40, line 6: "time slots", line 8: multiplexed DS0 bit streams") and does not teach the use carrier

frequency, which is known to those skilled in the art to relate to frequency division multiplexing (FDM).

The Office Action point to Hiller, ABSTRACT, figures 6-7, 11-12, 2- and 23, col. 11, line 23-col. 12, line 44, col. 26, line 27-col. 27, line 7, col. 28, line 53-col. 29, line 14, and further indicates that “-converting/remapping VPI/VCI and sending to user so that the terminal at the user does not know which carrier frequency is used to send data.” Applicants respectfully disagree and cannot find where in these sections the above is disclosed. However, Hiller does teach in col. 29, lines 10-15, that the “computers or other terminal that send or receive data have reserved adequate bandwidth for sending and receiving such data before making a request for a connection through an ATM-CM,” which implies that the network switch knows the details of said access network for directing signals to an intended destination terminal.

Accordingly, there is no suggestion at all in either of Hiekali or Hiller with regard to channel cluster modules, each arranged for transmitting downstream signals on a respective carrier frequency or said access node switch controlling all of the access-network-specific switching without said access node switch having to know a carrier frequency allocated to a terminal coupled to a sub-network of the plural sub-networks. Thus, the combination of references the Office Action proposes accordingly fails to disclose, suggest or feature at least the above-mentioned aspects of claim 1.

Next, it is not seen how Hiller’s ATM distribution network provides the motivation to combine as asserted in the Office Action, without improper hindsight by “use[ing] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention,” see *In Re Denis Rouffet*, 47

USPQ.2d 1453, 1457-58 (Fed. Cir. 1998). Although, Hiller suggests a ATM distribution network to manage large telecommunication networks, it is used to solve a particular problem (i.e. decreasing switching unit resources), and no motivation has been provided by the Office Action to show reasons that the skilled artisan, confronted with the same problems as the inventor would select the elements from the cited prior art references for combination in the manner claimed, see *Id.*

In the matter of obviousness there is a great emphasis placed on “the importance of the motivation to combine.” For example, the court in Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc. 231 F. 3d. 1339, 56 USPQ2d. 1641, 1644 (Fed. Cir. 2000) found that:

an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *id.* quoting *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, instant independent claims 1, 10 and 20 are allowable and the rejection should be withdrawn.


For at least all of the above reasons, the proposed combination of prior art would not have been obvious, and, moreover, would not meet all of the limitations of the invention as recited in claims 1, 10 and 20.

Further, the remaining claims are dependent from one of the independent claims discussed above, and are believed allowable for at least the same reasons and any rejections thereof should be withdrawn.

In view of the above analysis, it is respectfully submitted that the referenced teachings, whether taken individually or in combination, fail to anticipate or render obvious the subject matter of any of the present claims. It is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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